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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,636

04/12/2004

Minyu Li

1840US11

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43896

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07/08/2008

ECOLAB INC.

MAIL STOP ESC-F7, 655 LONE OAK DRIVE

EAGAN, MN 55121

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/822,636	Applicant(s) LI ET AL.	
	Examiner Patrick D. Niland	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
4a) Of the above claim(s) 22-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 41-57 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/14/05, 4/13/05, 2/18/05, 11/8/04, 8/30/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Applicant's election of group I drawn to a composition and a kit (claims 1-21 and 41-57 in the reply filed on 4/24/08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3-4 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. Claims 3-4 and 43 have the effect of incorporating by reference "essential material" by reference to the National Association of Printing Ink Manufacturers in their NPIRI Raw Materials Data Handbook and the Society of Dyers and Colourists Colour Index though the incorporation by reference does not properly incorporate by reference since it lacks the language required by 37 CFR 1.57. Such incorporation of essential material is improper. See MPEP 608.01(p): particularly (c) "Essential material" may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication,

which patent or patent application publication does not itself incorporate such essential material by reference. “Essential material ” is material that is necessary to:

(1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112; (2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112. The specification therefore does not contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-21 and 41-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 3-4 and 43 have the effect of incorporating by reference “essential material” by reference to the National Association of Printing Ink Manufacturers in their NPIRI Raw Materials Data Handbook and the Society of Dyers and Colourists Colour Index though the incorporation by reference does not properly incorporate by reference since it lacks the language required by 37 CFR 1.57. Such incorporation of essential material is improper. See MPEP 608.01(p): particularly (c) “ Essential material ” may be incorporated by reference, but only

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by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. “Essential material ” is material that is necessary to:

- (1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112; (2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112. The instant claims therefore fail to particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

B. The instant claims require “increased lightness value”. It is unclear what it is increased relative to.

6. Claims 16-17 and 54-55 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the lightness value L/Hiding Power ratios disclosed in the instant specification, does not reasonably provide enablement for the full range of “above about 30”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The claimed range reads on up to infinity and the applicant has provided no guidance how to obtain the claimed values in the upper portion of the claimed range. It appears that these upper values would be difficult to impossible to achieve.

7. Claims 18-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the whiteness index/500nm absorbance coefficient ratios disclosed in the instant specification, does not reasonably provide enablement for the full range of "above about 40". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The claimed range reads on up to infinity and the applicant has provided no guidance how to obtain the claimed values in the upper portion of the claimed range. It appears that these upper values would be difficult to impossible to achieve.

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1-21 and 41-57 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-82 of copending Application No. 10/843014. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The different words “pigment” and “agent” are not seen as making a scope difference particularly in view of copending claims 2-12 and the fact that the agent and pigment both give the same affect and encompass the same group of materials, e.g. all materials that give the claimed effect.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-21 and 41-57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-82 of copending Application No. 10/843014. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope to such an extent that one would not practice the inventions of the instant claims without practicing the inventions of the copending claims and vice versa.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-21 and 41-57 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-69 of copending Application No. 10/857593. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope to such an extent that one would not practice the inventions of the instant claims without practicing the inventions of the copending claims because the instant claims encompass the copending claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-4, 8-9, and 13-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5147940 Biale.

Biale discloses the instantly claimed compositions at the abstract; column 1, lines 1-68, particularly 56-63 which meets the instant claims because such paints are necessarily useful as job-site renewable floor finish and the compositions of the disclosure contain the instantly claimed components and amounts thereof and must therefore necessarily have the ability to be used for the claimed use and well as possess the instantly claimed properties because it contains the instantly claimed ingredients and amounts thereof. See MPEP 2113. See also column 2, lines 64-68; column 3, lines 1-68; column 4, lines 1-68; column 5, lines 1-68, particularly 65-68 which falls within the scope of the instant claims 2 and 8; column 7, lines 26-45, which falls within the scope of the instant claims 20-21; and the remainder of the document.

16. Claims 1-5, 7-11, and 13-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5319018 Owens et al..

Owens discloses the instantly claimed compositions at the abstract; column 6, lines 23-56; column 7, lines 1-68; column 8, lines 1-68; column 9, lines 1-68, particularly 39 and 68; column 11, lines 1-68, particularly 9, 22, 46-48, 56 and 65; column 12, lines 1-68, particularly 25-28; column 14, lines 1-68, particularly 22-25 and 63, which amounts of zinc oxide fall within the scope of the instant claims 20-21, particularly considering "about"; and the remainder of the document, which meets the instant claims because such paints are necessarily useful as job-site renewable floor finish and the compositions of the disclosure contain the instantly claimed components and amounts thereof and must therefore necessarily have the ability to be used for the claimed use and well as possess the instantly claimed properties because it contains the instantly claimed ingredients and amounts thereof. See MPEP 2113. The dispersed polymers

meet the instant claims 8-11. The zinc oxide must have been submicron to function as required by the patentee in the coating.

17. Claims 1-5, 7-9, and 12-21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6316535 Caldwell et al..

Caldwell discloses a composition falling within the scope of the instant claims at the abstract; column 1, lines 50-67 and column 2, lines 1-7, noting the titanium dioxide, aluminum trihydrate, zinc oxide, barium sulfate, zinc sulfate, and urethane polyol, which falls within the scope of the instant claim 12, and column 2, lines 8-67; column 3, lines 10-26, which falls within the scope of the instant claims 20-21; and the remainder of the document noting the claims particularly, which meets the instant claims because such paints are necessarily useful as job-site renewable floor finish and the compositions of the disclosure contain the instantly claimed components and amounts thereof and must therefore necessarily have the ability to be used for the claimed use and well as possess the instantly claimed properties because it contains the instantly claimed ingredients and amounts thereof. See MPEP 2113. The dispersed polymers meet the instant claim 8.

18. Claims 1-6, 8-9, and 13-21 are rejected under 35 U.S.C. 102(a) as being anticipated by US Pat. Application Publication 2004/0010071 Gebhart et al..

Gebhart discloses compositions falling within the scope of the instant claims at the abstract; section [0015], [0047] of which the rutile titanium dioxide falls within the scope of the instant claims 1-6, sections [0048]-[0049], which encompasses the instantly claimed amounts of claims 20-21 and predicts the result of the pigment content, section [0050], [0055], [0058]-[0060], [0092]-[0095], the claims, and the remainder of the document, which meets the instant

claims because such paints are necessarily useful as job-site renewable floor finish and the compositions of the disclosure contain the instantly claimed components and amounts thereof and must therefore necessarily have the ability to be used for the claimed use and well as possess the instantly claimed properties because it contains the instantly claimed ingredients and amounts thereof. See MPEP 2113. The dispersed polymers meet the instant claim 8.

19. Claims 1-4, 8-9, 13-21, 41-43, 47-48, and 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5147940 Biale.

Biale discloses the instantly claimed compositions at the abstract; column 1, lines 1-68, particularly 56-63 which meets the instant claims because such paints are necessarily useful as job-site renewable floor finish and the compositions of the disclosure contain the instantly claimed components and amounts thereof and must therefore necessarily have the ability to be used for the claimed use and well as possess the instantly claimed properties because it contains the instantly claimed ingredients and amounts thereof. See MPEP 2113. See also column 2, lines 64-68; column 3, lines 1-68; column 4, lines 1-68; column 5, lines 1-68, particularly 65-68 which falls within the scope of the instant claims 2 and 8; column 7, lines 26-45, which falls within the scope of the instant claims 20-21; and the remainder of the document.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed combinations of ingredients and amounts thereof because they are disclosed by the patentee and would have been expected to give the properties of the compositions of the patentee.

Biale does not disclose packaging their compositions in a kit with instructions.

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It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to package the compositions of Biale in a kit with instructions, according to the instant claims 41-43, 47-48, and 52-55, because it is well known to package coating compositions with instructions for coating as every coating composition ever seen by the examiner had instructions for use printed on the package and such instructions give only their expected result. See MPEP 2112.01:

III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES
NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE
IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, ^{367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)} (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also In re Gulack, ^{703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)} ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability **[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.**").

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to package the compositions of the reference in a kit with instructions, as discussed above and with a clear coat component to give the well known clear coat/ base coat finish appearance, which meets the instant claims 56-57.

20. Claims 1-5, 7-11, 13-21, 41-44, 47-48, 49-50, and 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5319018 Owens et al..

Owens discloses the instantly claimed compositions at the abstract; column 6, lines 23-56; column 7, lines 1-68; column 8, lines 1-68; column 9, lines 1-68, particularly 39 and 68; column 11, lines 1-68, particularly 9, 22, 46-48, 56 and 65; column 12, lines 1-68, particularly 25-28; column 14, lines 1-68, particularly 22-25 and 63, which amounts of zinc oxide fall within the scope of the instant claims 20-21, particularly considering "about"; and the remainder of the document, which meets the instant claims because such paints are necessarily useful as job-site renewable floor finish and the compositions of the disclosure contain the instantly claimed components and amounts thereof and must therefore necessarily have the ability to be used for the claimed use and well as possess the instantly claimed properties because it contains the instantly claimed ingredients and amounts thereof. See MPEP 2113. The dispersed polymers meet the instant claims 8-11. The zinc oxide must have been submicron to function as required by the patentee in the coating.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed combinations of ingredients and amounts thereof because they are disclosed by the patentee and would have been expected to give the properties of the compositions of the patentee.

Owens does not disclose packaging their compositions in a kit with instructions.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to package the compositions of Owens in a kit with instructions, according to the instant claims 41-44, 47-48, which are met by the dispersed resin of Owens, 49-50, and 52-55, because it is well known to package coating compositions with instructions for coating as every coating composition ever seen by the examiner had instructions for use printed on the package and such instructions give only their expected result. See MPEP 2112.01:

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IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability **[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.**").

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to package the compositions of the reference in a kit with instructions, as discussed above and with a clear coat component to give the well known clear coat/ base coat finish appearance, which meets the instant claims 56-57.

21. Claims 1-5, 7-9, 12-21, 41-44, 47-48, 49-50, and 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6316535 Caldwell et al..

Caldwell discloses a composition falling within the scope of the instant claims at the abstract; column 1, lines 50-67 and column 2, lines 1-7, noting the titanium dioxide, aluminum trihydrate, zinc oxide, barium sulfate, zinc sulfate, and urethane polyol, which falls within the scope of the instant claim 12, and column 2, lines 8-67; column 3, lines 10-26, which falls within the scope of the instant claims 20-21; and the remainder of the document noting the claims particularly, which meets the instant claims because such paints are necessarily useful as job-site renewable floor finish and the compositions of the disclosure contain the instantly claimed components and amounts thereof and must therefore necessarily have the ability to be used for the claimed use and well as possess the instantly claimed properties because it contains the instantly claimed ingredients and amounts thereof. See MPEP 2113. The dispersed polymers meet the instant claim 8.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed combinations of ingredients and amounts thereof because they are disclosed by the patentee and would have been expected to give the properties of the compositions of the patentee.

Caldwell does not disclose packaging their compositions in a kit with instructions.

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It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to package the compositions of Caldwell in a kit with instructions, according to the instant claims 41-44, 47-48, which are met by the dispersed resin of Caldwell, and 51-55, because it is well known to package coating compositions with instructions for coating as every coating composition ever seen by the examiner had instructions for use printed on the package and such instructions give only their expected result. See MPEP 2112.01:

III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES
NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE
IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, ³⁶⁷ F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability **[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.**").

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to package the compositions of the reference in a kit with instructions, as discussed above and with a clear coat component to give the well known clear coat/ base coat finish appearance, which meets the instant claims 56-57.

22. Claims 1-6, 8-9, 13-21, 41-45, 47-48, and 52-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. Application Publication 2004/0010071 Gebhart et al..

Gebhart discloses compositions falling within the scope of the instant claims at the abstract; section [0015], [0047] of which the rutile titanium dioxide falls within the scope of the instant claims 1-6, sections [0048]-[0049], which encompasses the instantly claimed amounts of claims 20-21 and predicts the result of the pigment content, section [0050], [0055], [0058]-[0060], [0092]-[0095], the claims, and the remainder of the document, which meets the instant claims because such paints are necessarily useful as job-site renewable floor finish and the compositions of the disclosure contain the instantly claimed components and amounts thereof and must therefore necessarily have the ability to be used for the claimed use and well as possess the instantly claimed properties because it contains the instantly claimed ingredients and amounts thereof. See MPEP 2113. The dispersed polymers meet the instant claim 8.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed combinations of ingredients and amounts thereof because they are disclosed by Gebhart and would have been expected to give the properties of the compositions of Gebhart.

Gebhart does not disclose packaging their compositions in a kit with instructions.

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to package the compositions of Gebhart in a kit with instructions, according to the instant claims 41-44, 47-48, which are met by the dispersed resin of Gebhart, and 51-55, because it is well known to package coating compositions with instructions for coating as every coating composition ever seen by the examiner had instructions for use printed on the package and such instructions give only their expected result. See MPEP 2112.01:

III. PRODUCT CLAIMS – NONFUNCTIONAL PRINTED MATTER DOES
NOT DISTINGUISH CLAIMED PRODUCT FROM OTHERWISE
IDENTICAL PRIOR ART PRODUCT

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. In re Ngai, **>367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)< (Claim at issue was a kit requiring instructions and a buffer agent. The Federal Circuit held that the claim was anticipated by a prior art reference that taught a kit that included instructions and a buffer agent, even though the content of the instructions differed.). See also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983)("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability **[T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.**").

It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to package the compositions of the reference in a kit with instructions, as discussed above and with a clear coat component to give the well known clear coat/ base coat finish appearance, which meets the instant claims 56-57.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796